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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,729	12/27/2001	Gabriele Perego	08719.0195	1975

7590 03/26/2004
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,729

Applicant(s)

PEREGO ET AL.

Examiner

Jill M. Gray

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-42 and 45-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-37 is/are allowed.
- 6) ☒ Claim(s) 38-42 and 45-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 10, 2004 has been entered.

Response to Amendment

The rejection of claim 24-27 and 30-37 under 35 U.S.C. 102(b) as being anticipated by and claims 28-29 under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Publication H10-283851 is withdrawn in view of applicants' arguments.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 56-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Publication H10-283851, for reasons of record.

Claims 56-57 are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product

Art Unit: 1774

was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964,966 (Fed. Cir. 1985).

Claims 47, 52, and 56-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al, 5,561,185 (Hashimoto).

Hashimoto teaches a polymeric composition comprising a polyethylene, a radical initiator, and at least one unsaturated carboxylic acid that is present in an amount of from 0.01 to 1.0 parts by weight, per claim 47. In addition, the radical initiator can be an organic peroxide, as required by claim 51. See column 4, lines 35-51. As to claims 56-57, these claims are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964,966 (Fed. Cir. 1985).

Therefore, the prior art teachings of Hashimoto anticipate the invention as claimed in present claims 47, 52, and 56-57.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-46, 48-51, and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Publication H10-283851 (Normura) in view of Hashimoto et al, 5,561,185 (Hashimoto) as applied above to claims 47, 52, and 56-57.

Normura teaches an electric cable and composition essentially as claimed by applicants and comprises a polyethylene grafted with at least one unsaturated carboxylic acid of the general formula set forth by applicants in claim 38, further teaching that this carboxylic acid can be acrylic acid as required by claims 46 and 54-55. See page 5, lines 25-28 and page 6, lines 4-5. In addition, Nomura teaches a radical initiator of the same type contemplated by applicants in claim 53. As to the specific polyethylene, Nomura teaches that the polyethylene can be an ethylene homopolymer or copolymer, wherein the copolymer can be an α -olefin such as propylene and the homopolymer can be a low density polyethylene and have a density of 0.920g/cm^3 , as required by claims 39-42 and 48-51. See page 5, lines 22-27 and page 8, lines 21-24. Nomura does not teach the specific grafting method.

Hashimoto is as set forth above and teaches the formation of modified polyethylene wherein polyethylene and the unsaturated carboxylic acid are melted and kneaded in the presence of a peroxide, and the unsaturated carboxylic acid is present in an amounts ranging from 0.01 to 1.0 parts by weight. See column 4, lines 35-58. Clearly the teachings of Hashimoto would have provided direction to the skilled artisan at the time the invention was made, as to how to form modified polyethylene with the reasonable expectation of success of obtaining a grafted polyethylene suitable for electric cable usage. It would have been obvious to the skilled artisan at the time the

Art Unit: 1774

invention was made to form an electrical cable as taught by Nomura wherein the polyethylene grafted with carboxylic acid is derived from polyethylene, a radical initiator and at least one unsaturated carboxylic acid, as known in the art and taught by Hashimoto.

Therefore, when considered as a whole, the combined teachings of Nomura and Hashimoto would have rendered obvious the invention as claimed in present claims 38-42, 45-46, 48-51, and 53-55.

Response to Arguments

Applicant's arguments with respect to claims 38-42, 45-55 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

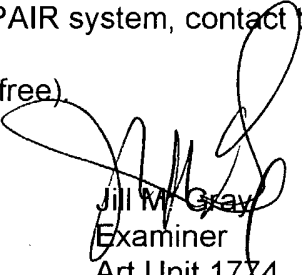
Claims 24-37 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1774

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray
Examiner
Art Unit 1774

jmg